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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/671,438	09/26/2003	Tetsuya Yamamura	0305369	5065

7590 10/26/2005

Intellectual Property Department
Mayer Brown Rowe & Maw LLP
1909 K Street NW
Washington, DC 20006-1101

EXAMINER	
MCCLENDON, SANZA L	
ART UNIT	**PAPER NUMBER**
1711	

DATE MAILED: 10/26/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/671,438	YAMAMURA ET AL.	
	Examiner	Art Unit	
	Sanza L. McClendon	1711	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *26 September 2003*.

2a)☒ This action is **FINAL**. 2b☐ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-13 and 15-67* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☒ Claim(s) *21-25 and 54-58* is/are allowed.

6)☒ Claim(s) *1-13,15-20,26-53 and 59-67* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☒ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☒ Certified copies of the priority documents have been received in Application No. 08/898,407.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Response to Amendment

1. In response to the Amendment received on October 5, 2005, the examiner has carefully considered the amendments. The examiner acknowledges the cancellation of claim 14 and the addition of new claims 66-67.

Response to Arguments

2. Applicant's arguments filed October 5, 2005 have been fully considered but they are not persuasive. Applicant argues that the claims are distinguished over Chikaoka et al because said reference requires the presence of a thermoplastic polymer compound as an essential component. This is not persuasive since applicant's claims are open to other components (i.e., comprising language). Therefore applicant's claimed composition is open to other components such as thermoplastic polymer compounds therefore the examiner deems that Chikaoka et al still anticipates the claimed invention. Applicant's statement that the addition of said thermoplastic polymer would provide a composition with significantly different properties when cured is an unsubstantiated allegation. Applicant has provided any evidence to these facts, thusly the composition is still deemed to inherently have the same properties as claimed by applicant. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim.

Applicant states that the examiner has failed to establish that said composition of Chikaoka et al would exhibit dimensional accuracy. The examiner refers applicant to the abstract portion of Chikaoka et al, which states that said composition enables the production of highly precise solid

shapes. In addition, per column 4, lines 60-62, Chikaoka et al states that said composition results in high precision moldings and said described composition is a superior sterolithographic resin composition. Applicant also states that the examiner/reference fails to constitute selectively curing a photo-curable resin composition. The examiner refers applicant to column 11 of Chikaoka et al (6,130,025), which appears to describe selectively curing a photocurable composition that anticipates that claimed invention.

With respect to applicant's arguments regarding the §103(a) rejection, Applicant appears to be arguing that Igarashi et al is not analogous art and therefore the rejection is improper. In response to applicant's argument that Igarashi et al is nonanalogous art, it has been held that a prior art reference must either be in the field of applicant's endeavor or, if not, then be reasonably pertinent to the particular problem with which the applicant was concerned, in order to be relied upon as a basis for rejection of the claimed invention. See *In re Oetiker*, 977 F.2d 1443, 24 USPQ2d 1443 (Fed. Cir. 1992). In this case, the examiner deems that Igarashi et al provides that it is well known in the art of epoxy composition that when oxetane compounds are added provide for compositions having rapid curability, as well as, excellent inner curability. Therefore the examiner deems that Igarashi et al is a relevant reference, especially since applicant is claimed epoxy/oxetane composition.

In response to applicant's arguments, the recitation for photo-fabrication has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the

preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951). The examiner ascertains that applicant is claiming a composition comprising components (a) - (c). Additionally, the examiner deems that Igarashi et al provides that it is well known in the art of epoxy composition that when oxetane compounds are added provide for compositions having rapid curability, as well as, excellent inner curability. Therefore the examiner deems that Igarashi et al is a relevant reference, especially since applicant is claimed epoxy/oxetane composition.

Additionally, new claims 66-67 are deemed to be unpatentable over the prior art made of record and will, therefore, be added to the rejections–see below. Chikaoka et al teaches using at least 50% by weight of another cationically polymerizable compound in combination with an epoxy compounds. Said another cationically polymerizable compound can be an oxetane compound. Therefore the claim is read in the reference. The contents of claim 67 can be found throughout the disclosure of Chikaoka et al.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

4. Claims 1, 3-8, 10-11, 13, 27, 30, 33, 36, 39, 42, 45 48 and 66-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chikaoka et al (WO 96/35756) and US 6,103,025.

Note: US 6,130,025 is being used as the English language equivalent for WO 96/35756.

5. Claims 1-13 and 15-20, 26-53, 59-67 are rejected under 35 U.S.C. 103(a) as being unpatentable over Chikaoka et al (WO 96/35756) in view of Igarashi et al (5.674,922) as evidenced by Ohkawa et al (5,434,196).

Priority

6. Applicant cannot rely upon the foreign priority papers to overcome this rejection because a translation of said papers has not been made of record in accordance with 37 CFR 1.55. See MPEP § 201.15.

Allowable Subject Matter

7. Claims 21-25 and 54-58 are allowed.

Conclusion

8. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

1. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sanza L. McClendon whose telephone number is (571) 272-1074. The examiner can normally be reached on Monday through Friday 7:30-4:00.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, James Seidleck can be reached on (571) 272-1078. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Sanza L McClendon
Examiner
Art Unit 1711

SMc

James J. Seidleck
Supervisory Patent Examiner
Technology Center 1700